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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,079	04/10/2001	Robert Smart	169.2021	7417
5514	7590	05/03/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			SON, LINH L D	
30 ROCKEFELLER PLAZA			ART UNIT	
NEW YORK, NY 10112			PAPER NUMBER	
			2135	

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/829,079	Applicant(s) SMART ET AL.	
	Examiner Linh LD Son	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-10,12,13,15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-10,12,13,15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is responding to the Amendment received on 02/06/06.
2. Claims 1-4, 6-10, 12-13, and 15-16 are pending. Claims 5, 11, and 14 are canceled. Claims 15-16 are newly added claims.

Information Disclosure Statement

3. The information disclosure statement filed 05/22/01 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 6-10, 12-13, and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al, US/5633932 (Cited in PTO 892 dated 11/02/05), hereinafter "Davis", in view of Lang, US/5191611.

6. As per claims 1 and 2:

Davis discloses "A method of conducting, in relation to a print job, a printing process between an originating device and a printer, said method-comprising steps of:

Connecting a physical security key to the originating device;

initiating, in association with the physical security key connected to the originating device, the printing process at the originating device for outputting the print job from the printer" in (Col 4 lines 50-65, and Col 6 lines 20-33);

"suspending the printing process prior to outputting the print job from the printer" in (Col 5 lines 1-25, and lines 15-20);

"connecting the physical security key to the printer; and

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enabling, in association with the physical security key connected to the printer, the suspended printing process to output the print job from the printer” in (Col 5 lines 34-65).

Davis further teaches of the sending node or the application referring to as the originating device authenticating with the printer-key server for using a key to encrypting the information before starting the secure printing process in (Col 3 lines 40-55).

However, Davis does not specifically teach of “Connecting a physical security key to the originating device” before initiating a printing process.

Nevertheless, Lang discloses the “Method and Apparatus for protecting material on storage media and for transferring material on storage media to various recipients” invention, which includes a method of connecting a smart card to the sending device to authenticate and utilize the information stored in the smart card to encrypt the data before sending it to a destination for printing (Col 10 lines 60-65, Col 9 lines 15-27, and Col 9 lines 29-60).

Therefore, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to modify Davis' invention to incorporate Lang's teaching of using the smart card at both party to ensure a high security transaction.

7. As per claims 3 and 6:

Davis discloses “A method according to claims 1 and 4, wherein a private key corresponding to a public key is embodied physically as the physical security key” in (Col 4 lines 39-55)

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8. As per claim 4:

Davis discloses "A system for conducting a secure printing process, in relation to a print job, between an originating device and a printer, wherein the originating device and the printer communicate over a network, said system comprising:

a security key interface (Col 5 lines 50-65) at the originating device, adapted to connect a physical security key to the originating device;

"a user interface, adapted to initiate, in association with the physical security key connected to the originating device, the printing process at the originating device for outputting the print job from the printer" in (Col 4 lines 50-65, and Col 6 lines 20-33;

"at least one processor module, adapted to suspend the printing process prior to outputting the print job from the printer" in (Col 5 lines 13-25); and

"a local user interface at the printer, adapted to enable input of the corresponding print job specific security key information, wherein said at least one processor module is adapted to enable, in association with the physical security key connected to the printer, the suspended printing process to output the print job from the printer" in (Col 5 lines 34-65).

Davis further teaches of the sending node or the application referring to as the originating device authenticating with the printer-key server for using a key to encrypting the information before starting the secure printing process in (Col 3 lines 40-55).

However, Davis does not specifically teach of "Connecting a physical security key to the originating device" before initiating a printing process.

Nevertheless, Lang discloses the "Method and Apparatus for protecting material on storage media and for transferring material on storage media to various recipients" invention, which includes a method of connecting a smart card to the sending device to authenticate and utilize the information stored in the smart card to encrypt the data before sending it to a destination for printing (Col 10 lines 60-65, Col 9 lines 15-27, and Col 9 lines 29-60).

Therefore, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to modify Davis' invention to incorporate Lang's teaching of using the smart card at both party to ensure a high security transaction.

9. As per claim 7:

Davis discloses "A computer program recorded on a computer-readable medium, the program comprising software code portions for performing the steps of claim 1" in (Col 3 lines 30-35).

10. As per claim 8:

Davis discloses "A computer readable medium storing a computer program, wherein said computer program comprises software code portions for performing the steps of claim 1" in (Col 4 lines 1-5).

11. As per claims 9 and 12:

Davis discloses "A printing method comprising the steps of:

Encrypting image data at an originating device to initiate a printing process for printing the image data on a printer by using public key information that corresponds to private key information” in (Col 4 lines 39-56);

“suspending the printing process prior to printing image data on the printer” in (Col 5 lines 15-20, Col 4 lines 39-65, and Col 6 lines 5-33);

“connecting a physical security key embodying the private key information to the printer; and

decrypting the encrypted image data to enable, the suspended printing process to print the image data on the printer, by using the private key information embodied by the physical security key connected to the printer” in (Col 5 lines 50-65).

Davis further teaches of the sending node or the application referring to as the originating device authenticating with the printer-key server for using a key to encrypting the information before starting the secure printing process in (Col 3 lines 40-55).

However, Davis does not specifically teach of “Connecting a physical security key to the originating device” before initiating a printing process.

Nevertheless, Lang discloses the “Method and Apparatus for protecting material on storage media and for transferring material on storage media to various recipients” invention, which includes a method of connecting a smart card to the sending device to authenticate and utilize the information stored in the smart card to encrypt the data before sending it to a destination for printing (Col 10 lines 60-65, Col 9 lines 15-27, and Col 9 lines 29-60).

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Therefore, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to modify Davis' invention to incorporate Lang's teaching of using the smart card at both party to ensure a high security transaction.

12. As per claims 10 and 13:

Davis discloses "A system according to claims 9 and 12, wherein the print job specific security key information is input via a local user interface at a computer communicating with the originating device over a network" in (Col 4 lines 39-55, Col 6 lines 52-65, and Col 6 lines 20-33), wherein the image data is stored at the originating device" in (Col 1 lines 30-55, and Col 4 lines 23-37).

13. As per claims 15 and 16:

Lang discloses "A method and a system according to claims 1 and 4, wherein the physical security key is specific to the print job" in (Col 10 lines 60-65).

Response to Arguments

14. Applicant has amended claims 1-4, 6, 9, and 12, which necessitated new grounds of rejection. See Rejections above.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
16. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linh LD Son whose telephone number is 571-272-3856. The examiner can normally be reached on 9-6 (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Linh LD Son
Examiner
Art Unit 2135


HOSUK SONG
PRIMARY EXAMINER